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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,449	03/20/2000	Hideki Hirata	0083-1131-0	6033

7590 11/29/2001

Oblon Spivak McClelland Maier & Neustadt
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

MF

Office Action Summary

Application No.

09/531,449

Applicant(s)

HIRATA, HIDEKI

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 5. 6) ☐ Other:

DETAILED ACTION

Claim Rejections – 35 USC § 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over Yoshiaki et al. JP 10269624 A.
3. Yoshiaki discloses a light transmission layer formed on a information recording layer on a main surface of a transparent substrate after dispersing spacer pressurized particles made of resin, where the light transmission layer is of a uniform thickness (abstract) where the pressurized particles are bonding materials adhering the light transmission layer to the substrate. Although Yoshiaki does not explicitly disclose the thickness, it would have been obvious to one of ordinary skill in the art to optimize the light transmission layer because discovering optimum or workable ranges involves only routine skill in the art.

Claim Rejections – 35 USC § 103(a)

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Yoshiaki et al. JP 10269624 A in view Mikio et al. JP 62003443 A.

5. Yoshiaki is relied upon for claims 1 and 5. Yoshiaki does not disclose the light transmitting layer is made of polycarbonate or that it is prepared by the casting technique.

Mikio teaches a recording layer with a protecting layer on it made of polycarbonate by a casting method (abstract). The protecting layer may act as a light transmitting layer due to its transparency and absorbing of light waves.

Yoshiaki and Mikio are analogous art because they are from the same field of recording media. It would have been obvious to include the polycarbonate material in the light transmission layer of Yoshiaki and the casting method because Mikio teaches that the polycarbonate increases the durability of the protective layer (light transmitting layer). The casting method referred to is a product by process step. The process adds no positive limitation to the claim. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966.

Claim Rejections – 35 USC § 103(a)

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being obvious over Yoshiaki et al. JP 10269624 A in view Ikenaga et al. (U.S. 4,719,171).

7. Yoshiaki is relied upon for claims 1 and 5. Yoshiaki does not disclose the adhesive layer of the light transmitting layer is made of acrylic resin.

Ikenaga teaches a disc having a light transmitting layer doubled as a protective layer, put together with an adhesive, where the protective layer is formed of a transparent resin such as an acrylic resin (column 11, line 57 through column 12, line 4).

Yoshiaki and Ikenaga are analogous art because they are from the same field of optical media. It would have been obvious to include the adhesive layer made of acrylic resin in the light transmission layer of Yoshiaki because Ikenaga teaches that the acrylic resin increases the light transmissive properties of the layer.

Claim Rejections – 35 USC § 103(a)

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over Yoshiaki et al. JP 10269624 A in view Tamura et al. (U.S. 5,328,816).

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9. Yoshiaki is relied upon for claims 1 and 5. Yoshiaki does not disclose the light transmitting layer being cut off by laser processing.

Tamura teaches a process for producing an information recording medium comprising a substrate with a recording and protective layer formed by cutting the resulting substrate sheet into information recording mediums (abstract) resulting in excess material, such as the protective layer (light-transmitting sheet) cut off that is not adhered to the substrate. Tamura teaches cutting carried out by laser cutting to obtain the information mediums (column 4, lines 54-56).

Yoshiaki and Tamura are analogous art because they are from the same field of information media. It would have been obvious to cut the excess light transmitting sheet of Yoshiaki because Tamura teaches that this process is known in the art in order to obtain the final product for consumer use.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
November 14, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

